

REMARKS

The above Amendments and these Remarks are in reply to the Office Action mailed October 14, 2005. Claims 1-6 and 10-46 are presented herewith for consideration.

Applicant appreciates the Examiner's consideration of Applicant's remarks and the withdrawal of the previous rejections.

I. Rejection of Claims 1-6, 10-20, 22-33, 35-42 and 44-46 Under 35 U.S.C. §103(a)

Claims 1-6, 10-20, 22-33, 35-42 and 44-46 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,163,779 ("Mantha") in view of U.S. Publication No. 2002/0116444 ("Chaudhri").

Applicant initially respectfully submits that there is no teaching or suggestion in the references or prior art in general that would lead one of skill in the art to combine the teachings of Mantha with Chaudhri. Before references may be combined to render a claimed invention obvious, there must be some suggestion or motivation found in the art to make the combination. *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998). "It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements." *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957 (Fed. Cir. 1997). Moreover, the fact that references can be combined is insufficient to meet this criterion. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Similarly, the fact that the combination would be well within the ordinary skill in the art, by itself, is insufficient to meet this criterion. *Al-Site Corp. v. VSI Intern., Inc.*, 174 F.3d 1308, 1324 (Fed. Cir. 1999). The examiner needs to show the additional step of how this knowledge of the skilled artisan.

In the present invention, the Examiner indicates that one of ordinary skill in the art would have used "the Chaudhri structure in Mantha in order to provide improved content distribution and publisher rules handling." Applicant respectfully submits that the problem addressed and solved by Mantha is not related to content distribution or publisher rules handling. Thus, one of skill in the art would have no indication or motivation to combine Chaudhri into Mantha.

In particular, Mantha relates to a system for copying an html document and embedded objects/links from a network server onto a hard drive of a client device. As stated in Mantha:

It is a primary goal of the present invention to provide a method for copying or "saving" a Web page onto a local storage to enable a user to browse the page at a subsequent time. (Col. 1, lines 60-65).

The browsing at a subsequent time refers to pulling the copy of the saved web page from the client's local hard drive. Mantha is clear that, once the page is copied, the page is accessed from the local hard drive, not from the network server. Subsequent browsing of the page occurs on the client side, from the copy stored on the client side hard drive.

Conversely, the problem and solution addressed by Chaudhri are not related to browsing a page stored on a local server. Of relevance to the present invention, a specific aspect of browsing a page stored on a local server addressed by Mantha is the qualifying of a URL stored on a local drive to another location on the local drive or to a network location (Col. 10, lines 60 – 65). However, Chaudhri is wholly unconcerned with qualifying URLs. While Chaudhri does disclose modifying a URL, the modification is does not relate to qualifying the URL to its source location on the network.

In view of this, applicant respectfully submits that one of average skill in the art would never have looked to Chaudhri in relation to Mantha to address or solve the problems addressed by the present invention. Applicant respectfully submits that the stated motivation to combine the references - to provide improved content distribution and publisher rules handling – would not be found as Mantha does not relate to content distribution or publisher rules. Moreover, the stated motivation is too abstract and general a motivation to cause one of skill in the art to combine the references.

Furthermore, even if the references were to be combined, applicant respectfully submits that the combined teaching of the references still fails to render obvious the invention recited in Claims 1-6, 10-20, 22-33, 35-42 and 44-46. In particular, the Examiner bases the rejection in part on the fact that Chaudhri allegedly discloses a system, “wherein the client is on a different network from the server,” and points to Figs. 3, 5 and 6 as support.

However, applicant respectfully submits that there is no such teaching in Figs. 3, 5 and 6. In fact, Fig. 3 shows publisher content 40 and viewer browser 50 connected on the same network (*i.e.*, the Internet). One of the arrows from publisher content 40 extends straight across, over the Internet, to view browser 50. Therefore, it is respectfully submitted that Chaudhri does not teach or suggest a system wherein the client is on a different network from the server.

To establish a case of *prima facie* obviousness of a claimed invention, **all** the claim limitations must be taught or suggested by the prior art. *Application of Glass*, 472 F.2d 1388,

1392 (CCPA 1973)(emphasis added). All claim limitations are significant, and must be given weight and effect *vis-a-vis* the patentability of the claims. *Application of Saether*, 492 F.2d 849, 852 (CCPA 1974). It is therefore respectfully requested that the rejection of 1-6, 10-20, 22-33, 35-42 and 44-46 under 35 U.S.C. §103(a) be withdrawn.

II. Rejection of Claims 21, 34 and 43 Under 35 U.S.C. §103(a)

Claims 21, 34 and 43 are rejected under 35 U.S.C. §103(a) as being unpatentable over Mantha and Chaudhri* as applied to Claims 2, 22 and 35 above, and further in view of U.S. Patent No. 6,581,065 ("Rodkin").

Claims 21, 34 and 43 rely on Claims 2, 22 and 35, respectively. As discussed above, it is respectfully submitted that Claims 2, 22 and 35 are not obvious over the combination of Mantha with Chaudhri on the grounds that one of skill in the art would not have combined the two references and also that, even if combined, the combination does not teach or suggest the claimed invention. Rodkin adds nothing to the teachings of Mantha and Chaudhri in this regard. It is therefore respectfully requested that the rejection of claims 21, 34 and 43 under 35 U.S.C. §103(a) be withdrawn.

Based on the above amendments and remarks, reconsideration of Claims 1-6, and 10-46, is respectfully requested.

The Examiner's prompt attention to this matter is greatly appreciated. Should further questions remain, the Examiner is invited to contact the undersigned attorney by telephone.

Enclosed is a PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.136 for extending the time to respond up to and including today, April 14, 2006.

* In this rejection, there is no mention of Chaudhri. However, as Chaudhri forms part of the underlying rejection of Claims 2, 22 and 35 on which Claims 21, 34 and 43 rely, applicant assumes that this rejection is also based on the combination of Mantha and Chaudhri and further in view of Rodkin.

The Commissioner is authorized to change any underpayment or credit any overpayment to Deposit Account No. 501826 for any matter in connection with this document.

Respectfully submitted,

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